



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,637	03/13/2002	Slim Souissi	267/108	7391
27433	7590	12/16/2005	EXAMINER	
FOLEY & LARDNER LLP 321 NORTH CLARK STREET SUITE 2800 CHICAGO, IL 60610-4764			HASHEM, LISA	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/098,637

Applicant(s)

SOUISSI ET AL.

Examiner

Lisa Hashem

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### FINAL DETAILED ACTION

1. Regarding claims 10-16, please see all rejections in the Non-Final Office Action filed on 3-24-2005.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 17, and 19-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,925,299 by Sofer et al, hereinafter Sofer.

Regarding claim 1, Sofer discloses a method for complete message delivery to a communication device (Fig. 2, 16), comprising:  
receiving a message notification through a first communication network (Fig. 2, 36), the message notification corresponding to a complete message (col. 8, lines 40-59);  
connecting to a message server (Fig. 2, 26) through a second communication network (Fig. 2, 14); and  
downloading the complete message through the second communication network (col. 7, lines 18-27).

Regarding claim 2, the method of claim 1, wherein Sofer further discloses the message notification is a mobile terminated SMS message (col. 8, lines 40-67).

Regarding claim 17, Sofer discloses a system for complete message delivery to a communication device (Fig. 2, 16), comprising:  
a first communication network (Fig. 2, 36) and a second communication network (Fig. 2, 14);  
a communication device (Fig. 2, 16) adaptable to communicate over the first communication network and the second communication network;  
a message control module (Fig. 2, 26) configured to receive a complete message addressed to the communication device, notify the communication device of the message, and provide the complete message to the communication device upon request (col. 6, lines 12-15; col. 7, lines 18-27).

Regarding claim 19, the system of claim 17, wherein Sofer further discloses the message control module notifies the communication device of the complete message via the first communication network (Fig. 2, 36) (col. 8, lines 40-59).

Regarding claim 20, the system of claim 17, wherein Sofer further discloses the message control module notifies the communication device of the complete message via the second communication network (Fig. 2, 14) (col. 6, lines 24-28).

Regarding claim 21, the system of claim 17, wherein Sofer further discloses the complete message is provided to the communication device via the first communication network (Fig. 2, 36) (col. 7, lines 18-34; col. 9, lines 42-49).

Regarding claim 22, the system of claim 17, wherein Sofer further discloses the complete message is provided to the communication device via the second communication network (Fig. 2, 14) (col. 7, lines 18-27; col. 7, line 58 – col. 8, line 5).

Regarding claim 23, the system of claim 17, wherein Sofer inherently further discloses a

Art Unit: 2645

message filter (within the VMS) configured to screen the complete message prior to notifying the communication device of the complete message (Fig. 1, 100; col. 6, lines 12-15; col. 6, lines 36-56).

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer, as applied to claim 1 above, and in further view of U.S. Patent Application Publication No. Us 2005/0048958 by Katz et al, hereinafter Katz.

Regarding claim 3, the method of claim 2, wherein Sofer does not disclose the SMS message is encrypted.

Katz discloses a method for complete message delivery to a multi-mode communication device, comprising: receiving a message notification that is a SMS message and is encrypted (section 0090, line 1 – section 0091, line 38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Sofer to include SMS encryption as taught by Katz. One of ordinary skill in the art would have been lead to make such a modification since encrypting a SMS message to allow an authorized user to receive a message notification.

Art Unit: 2645

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer, as applied to claim 1 above, and in further view of U.S. Patent Application Publication No. Us 2005/0048958 by Mousseau et al, hereinafter Mousseau.

Regarding claim 4, the method of claim 1, wherein Sofer does not disclose the connecting step comprises establishing a secure VPN connection.

Mousseau discloses a method for complete message delivery to a multi-mode communication device (Fig. 1, 100) (see Abstract), comprising: receiving a message by establishing a secure VPN connection (section 0037, line 1 – section 0039, line 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Sofer to include VPN as taught by Mousseau. One of ordinary skill in the art would have been lead to make such a modification since VPN provides security in downloading messages to the communication device, wherein authorized users can view messages.

7. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer, as applied to claim 1 above, and in further view of U.S. Patent No. 6,333,973 by Smith et al, hereinafter Smith.

Regarding claim 5, the message of claim 1, wherein Sofer does not disclose parsing the message notification to determine a set of parameters pertaining to the complete message.

Smith discloses a method for complete message delivery to a multi-mode communication device (Fig. 1, 1100) (see Abstract), comprising:

Art Unit: 2645

receiving a message notification through a first communication channel (GSM signaling channel), (col. 7, lines 15-24), the message notification corresponding to a complete message (col. 7, line 40 – col. 8, line 10);  
connecting to a message server (e.g. voice mail server; Fig. 5, 5600) via the Message Center (Fig. 6, 6100) through a second communication channel (voice B-channel); and  
downloading the complete message through the second communication channel (col. 9, lines 35-60).

Wherein Smith further discloses parsing the message notification to determine a set of parameters pertaining to the complete message (Fig. 7A; col. 7, line 51-col. 8, line 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Sofer to include parsing the message notification to determine a set of parameters pertaining to the complete message as taught by Smith. One of ordinary skill in the art would have been lead to make such a modification to deliver a complete message to a communication device based on a set of parameters.

Regarding claim 6, the method of claim 5, wherein Smith further discloses the set of parameters comprises a sender and a subject (col. 8, lines 1-10 and lines 52-65; col. 9, lines 6-11; Fig. 8A).

Regarding claim 7, the method of claim 6, wherein Smith further discloses the set of parameters further inherently comprises a priority (col. 8, lines 1-10 and lines 46-65; Fig. 7A).

Regarding claim 8, the method of claim 5, wherein Smith further discloses the set of parameters comprises a unique message identifier (Fig. 7A; col. 8, lines 27-65).

Regarding claim 9, the method of claim 5, wherein Smith further discloses comparing the

Art Unit: 2645

set of parameters to an established criteria for retrieving complete messages (col. 7, line 40 – col. 8, line 65).

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer, as applied to claim 17 above, and in further view of U.S. Patent No. 6,625,461 by Bertacchi.

Regarding claim 18, the system of claim 17, wherein Sofer further discloses a database (Fig. 2, 24) adaptable to store a registration status pertaining to the communication device, wherein the communication device reports the registration status to the database and the database is updated (col. 1, lines 30-34; col. 6, lines 42-46).

Sofer does not disclose the communication device reports the registration status to the message control module and the message control module updates the database.

Bertacchi discloses a system for complete message delivery to a multi-mode communication device (Fig. 1, 10), comprising:  
a first communication network or first area and a second communication network or second area;  
a communication device adaptable to communicate over the first communication network and the second communication network (col. 4, lines 16-40);  
a message control module or message center (Fig. 1, 22) configured to receive a complete message addressed to the communication device, notify the communication device of the message, and provide the complete message to the communication device (col. 1, lines 23-41; col. 4, lines 16-26).

Wherein Bertacchi further discloses a database (Fig. 2, 20: HLR) adaptable to store a registration status pertaining to the communication device, wherein the communication device



Art Unit: 2645

reports the registration status to the message control module and the message control module updates the database (col. 7, line 62 – col. 8, line 16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sofer to include the communication device reports the registration status to the message control module and the message control module updates the database as taught by Bertacchi. One of ordinary skill in the art would have been lead to make such a modification since the message control module can update the database regarding the registration status based on the communication device reporting its status to the message control module.

#### *Response to Arguments*

9. Applicant's arguments filed 9-28-2005 regarding claims 10-16 have been fully considered but they are not persuasive.

Applicant did not argue claims 10-16 in the arguments. As noted in the Non-Final Office Action filed on 3-24-2005, Smith clearly discloses first and second communication channels.

10. Applicant's arguments, see Amendment filed 9-28-2005, with respect to the rejection(s) of claim(s) 1-9 and 17-23 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all rejection(s) above.

11. Accordingly, this action is **FINAL**.

*Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,298,232 by Marin et al discloses transmitting a voice message notification by a first or second network, wherein the voice message is located in the first network
- U.S. Patent No. 6,333,973 by Smith et al discloses receiving a message notification, the message notification corresponding to a complete message through a mobile telephone's GSM signaling channel; connecting to a message server through a communication network; and downloading the complete message through the mobile telephone's voice and data B-channels (col. 4, lines 25-35; col. 5, lines 5-8; col. 7, lines 15-24)

Art Unit: 2645

- U.S. Patent Application Publication No. 2003/0095643 by Fortman et al discloses receiving a message notification, the message notification corresponding to a complete message; connecting to a message server through a communication network; and downloading the complete message through the communication network (section 0047, line 1 – section 0052, line 13)
- U.S. Patent No. 6,317,485 by Homan et al discloses Homan discloses a method for complete message delivery to a communication device, comprising: receiving a message notification through a first communication network (e.g. paging network), the message notification corresponding to a complete message (col. 6, lines 21-27; col. 6, lines 37-49; col. 9, lines 33-46); connecting to a message server (Fig. 1A, 105) through a second communication network (e.g. telephone network); and downloading the complete message through the second communication network (col. 10, lines 26-41).

15. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-8300 (for formal communications intended for entry)

**Or call:**

(571) 272-2600 (for customer service assistance)

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

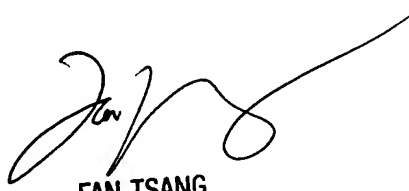
Art Unit: 2645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

lh  
December 12, 2005



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600